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09/387,764	09/01/1999	RAVI GANESAN	33500-19D	2988

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EXAMINER

NGUYEN, NGA B

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/387,764	Applicant(s) Ganesan et al.
	Examiner Nga B. Nguyen	Art Unit 3628
		
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
Period for Reply <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>three</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Jan 29, 2003</u></p> <p>2a) <input checked="" type="checkbox"/> This action is FINAL. 2b) <input type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>		
Disposition of Claims <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1-26 and 28</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) _____ is/are withdrawn from consideration.</p> <p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6) <input checked="" type="checkbox"/> Claim(s) <u>1-26 and 28</u> is/are rejected.</p> <p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.</p>		
Application Papers <p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a)<input type="checkbox"/> approved b)<input type="checkbox"/> disapproved.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
Priority under 35 U.S.C. § 119 <p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p> <p>a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p> <ol style="list-style-type: none"> 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). <p>*See the attached detailed Office action for a list of the certified copies not received.</p> <p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p>		
Attachment(s) <p>15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____</p> <p>18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p> <p>19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>20) <input type="checkbox"/> Other: _____</p>		

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DETAILED ACTION

1. This Office Action is the answer to the Amendment filed on January 29, 2003, which paper has been placed of record in the file.
2. Claim 27 has been canceled. Claims 1-26 and 28 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-26 and 28 have been considered but are not persuasive. In the arguments, applicant stated that nothing in Kitchen's teach regarding the receipt of the determined amount of the available bill. Examiner respectfully disagrees. See figure 9A, the user receives a new bill with the determined amount. Examiner also totally disagrees with applicant that Kitchen fails to discloses the determined amount of the available bill and the transmitted pay instruction are received by the central station in real time. See column 8, line 55-column 9, line 15, the user station transmits a payment instruction over the network to the central network station and the central network station perform an electronic fund transfer the appropriate amount to the biller account. Moreover, as requested by applicant, examiner provides the reference to support the obviousness in claims 1-15, 26, 28 as stated by examiner, the user network station transmits information relevant to an amount of an available bill and the biller determines the amount of an available bill based on the relevant information

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(see column 7, lines 10-32). In conclusion, examiner decides to maintains the previous rejection (see details below) and make this office action FINAL.

4. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

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6. Claims 16-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Kitchen et al, U.S. Patent No. 6,289,322.

Regarding to claim 16, Kitchen discloses an electronic bill payment system, comprising:
a database configured to store bill availability information identifying available bills of a plurality of different billers for a plurality of different users (column 6, lines 59-65);
a processor configured to receive a real time network communication of an amount of one of the available bills identified in the stored bill availability information for a first of a plurality of different users from a first of the plurality of different billers and a real time network communication of an instruction to pay the one available bill from the first user (column 6, lines 50-58 and column 8, lines 55-67); to generate a directive to pay the amount of the available bill based upon the received communicated pay instruction, and to store the received communicated amount in the database in association with the bill availability information identifying the one available bill (column 8, line 63-column 9, line 29).

Regarding to claim 17, Kitchen discloses the processor is further configured to transmit the stored bill availability information identifying the one available bill for the first user, prior to receive the real time network communication of the amount and d of the instruction to pay (column 7, line 65-column 8, line 37).

Regarding to claim 18, Kitchen discloses the database is further configured to store the bill availability information so as to further identify those of the identified available bills which required information relevant to the amount of those bills; and the one available bill is one of

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those of the plurality of available bills further identified as requiring relevant information (column 6, line 59-column 7, line 5).

Regarding to claim 19, Kitchen discloses the database is further configured to stored a previously received communicated amount of the available bill and the received amount of the one available bill (column 12, lines 65-column 13, line 5 and column 9, lines 15-20).

Claims 20-25 are written in computer software and have similar the limitations as found in claims 16-19 discussed above, therefore are rejected by the same rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-15 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen et al, U.S. Patent No. 6,289,322.

Regarding to claims 1, 6, and 7, Kitchen discloses an electronic bill payment network, comprising:

a plurality of user network stations associated with a plurality of different users, a first of the plurality of user network stations being associated with a first of the plurality of different

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users and operable to transmit, in real time, an instruction to pay the available bill (figure 1, items 120a-120d and column 8, lines 55-67) ;

a plurality of biller network stations associated with a plurality of different billers, a first of the plurality of biller network stations being associated with a first of the plurality of different billers and operable, in real time, to receive the transmitted information (figure 1, items 110a-110d and column 9, line 65-column 10, line 5); and

a central network station operable, in real time, to receive the determined amount of the available bill and the transmitted pay instruction, and to direct payment of the determined amount of the available bill based upon the transmitted instruction to pay that available bill (figure 1, item 140; column 6, lines 50-58 and column 8, lines 63-67).

Kitchen does not teach the user network station transmits information relevant to an amount of an available bill and the biller determines the amount of an available bill based on the relevant information such as product uses or meter reading. However, Kitchen does teach the user network station and the biller network station can communicate directly to transmit and receive the bill related information (column 9, line 65-column 10, line 5). Moreover, it is well known to determine the amount of the available bill based on the relevant information transmitted from the user. In most situations, the biller has the responsibility to determine the amount and due date for payment of a bill based on the user's usage information (The prior arts will be provided upon requested by Applicant). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to improve the method of

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Kitchen's by allowing the biller can determine the amount of the bill based on transmitted from the user for the purpose of allowing the user and the biller can communicate directly to exchange the bill related information.

Regarding to claim 2, Kitchen discloses the central network station is further operable to transmit bill availability information identifying at least two of the plurality of available bills for the first user; and the first user network station is further operable to receive the transmitted bill availability information, to select the available bill from the identified at least two available bills and to transmit a request for the available bill based upon the selection prior to transmitting the relevant information (column 7, lines 65-column 8, line 37).

Regarding to claim 3, Kitchen does not discloses the bill availability information identifies available bills without identifying an amount of each of the bills. Official notice is taken that it is obvious to modify the method of Kitchen in which the bill availability information does not contain an amount for the purpose of establishing the direct communication between the user and the biller to exchange the amount of the bill as discussed details in claim 1.

Regarding to claim 4, Kitchen further discloses a database configured to store the bill availability information so as to further identify those of the identified available bills which required information relevant to the amount of those identified available bills (column 6, line 59-column 7, line 5).

Regarding to claim 5, Kitchen further discloses the database is configured to store the determined amount (column 9, lines 15-20).

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Regarding to claim 8, Kitchen further discloses the transmitted information is indicative of a disputed portion of a previously determined amount of the available bill (column 10, lines 32-42).

Regarding to claim 9, Kitchen discloses the first biller network station is further operable, in real time, to transmit the available bill including a previously determined amount, and the determined amount of the available bill represents an adjustment to the previously determined amount (column 10, lines 35-42).

Claims 10-15 are method claims that parallel the limitations as found in claims 1, 2, 4-7, 9 discussed above, therefore, are rejected by the same rationale.

Claims 26-28 are method claim that have similar limitations as found in claims 1, 2, 4, 5, as discussed above, therefore, are rejected by the same rationale.

Conclusion

9. Claims **1-26 and 28** are rejected.
10. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Kolling et al. (US 5,963,925) discloses an electronic statement presentment system replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery.

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Heindel et al. (US 6,304,857) discloses an electronic billing system provides a set of tools for a biller to create and design a customized billing statement.

Neely (US 6,044,362) discloses a system for automated electronic invoicing and payment system for providing remote customer review of automated billing from an invoicer.

Ganesan et al. (US 6,334,116) discloses a method for centrally tracking transactions in an electronic billing system.

Dedrick (US 5,768,521) discloses general purpose metering mechanism for distribution of electronic information.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nga B. Nguyen, whose telephone number is (703)306-2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on (703)308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1113.

12. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks
c/o Technology Center 3600
Washington, D.C. 20231

or faxed to:

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(703) 305-7687, (for formal communications intended for entry)

or:

(703) 308-3961 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen
April 18, 2003



HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600